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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/602,108	06/23/2003	Andrew Walker	P-US-CS 1145	2249
7590 07/14/2005			EXAMINER KYLE, MICHAEL J	
Bruce S Shapiro Esquire Patent Department TW199 The Black & Decker Corporation 701 East Joppa Road Towson, MD 21286			ART UNIT 3677	PAPER NUMBER

DATE MAILED: 07/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/602,108

Applicant(s)

WALKER ET AL.

Examiner

Michael J. Kyle

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-25,33-37 and 43-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-25,33-37 and 43-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 6/18/04, 10/16/03, + 6/23/03 **ML**
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 12-25, 33-37, and 43-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mooty et al ("Mooty", U.S. Patent No. 6,308,378) in view of DeLuca et al ("DeLuca", U.S. Patent No. 6,591,456). With respect to claims 12-16, 20, 25, 33-35, Mooty discloses a tool comprising a housing (102), a motor within the housing (column 3, line 58), and a gripping portion (104). Mooty also discloses the gripping portion (104) to have an outer surface including at least one material (at 114, 116, 118) of higher coefficient of friction than the material of the housing tool. The tool is a power tool with an output member (105). The power tool is a power drill. The handle has opposite side surfaces each defining a gripping region. Mooty fails to disclose blister pack, clamping member, chambers, and the cover member, as claimed.

3. DeLuca teaches a cushioning device for a grip of a tool comprising a blister pack (100) with first and second flexible sheets (172, 174) defining at least one gel (column 12, lines 20-22) containing chamber (106), and where the first and second flexible sheets are sealed to each other at the periphery of the gel containing chambers. DeLuca further shows a clamping, or cover, member (210, 230, 250) made of a relatively hard material compared to the gel. The clamping or

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cover member includes apertures (254). DeLuca uses this arrangement to provide a comfortable, deformable grip, that conforms to the users grip. It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Mooty, such that Mooty includes the clamping member and blister pack of DeLuca around its grip, in order to provide a comfortable, deformable grip that conforms to a user's grip. A chamber enclosing the gel material (108) extends outwardly from the gripping portion (see figures 4 and 10). Both the gripping portion and chamber are simultaneously gripped. DeLuca also shows two discrete chambers extending outwardly from the side surfaces (see figures 4 and 10) and through the apertures of the cover member. The cover piece (210, 230, 250) forms at least part of the gripping portion.

4. With respect to claims 17 and 18, the combination of Mooty and DeLuca shows the chamber (106 of DeLuca) formed as a blister pack with gel material enclosed between upper and lower layers of flexible film (172, 174). The handle defines a recess, and the blister pack assembly is disposed in the recess (between the cover member and a base of the handle).

5. With respect to claim 19, DeLuca teaches a flexible layer as discussed above. Neither Mooty nor DeLuca show another flexible sheet disposed between the blister pack and the cover piece and having a protrusion extending through the aperture and accommodating the chamber. However, it appears, as presently claimed, this flexible sheet is just another layer on the blister pack. It is considered obvious, and within the knowledge of one having ordinary skill in the art to make to replace a single piece with multiple pieces. It would have been obvious to one having ordinary skill in the art at the time of the invention to modify DeLuca such that there is an additional flexible sheet or layer extending through an aperture in the cover piece.

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6. With respect to claims 21 and 22, the combination of Mooty and DeLuca discloses the chamber (106 of DeLuca) and cover piece (210, 230, 250 of DeLuca) to each have a curved outer surface, and the handle gripping portion includes a curved region that does not include the cover piece (portion 252 of DeLuca) where the cover piece has a curved outer surface that substantially merges into the curved region.

7. With respect to claims 23 and 24, DeLuca teaches the chamber to be formed as a blister pack assembly including gel material enclosed between upper and lower layers of flexible film (172, 174).

8. With respect to claim 36, DeLuca teaches four chambers (106) encapsulating a gel material, where two chambers protrude from each said gripping region (see figures 4 and 10). The chambers are discrete from one another.

9. With respect to claim 37, DeLuca teaches a cover piece (210, 230, 250, but neither Mooty nor DeLuca disclose the drill to comprise two cover pieces. However, separating a single part into multiple parts is considered to be within the level of one having ordinary skill in art. Doing so does not appear to create any specific utility, nor does it provide a clear advantage over the prior art. It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Mooty and DeLuca such that the cover piece of DeLuca is two pieces, as such a modification does not appear to produce a new or unexpected result as is within the skill of the art.

10. With respect to claims 43-45, Mooty discloses a power tool with a housing (102) having a handle (104), and motor to actuate an output member of the power tool. Mooty fails to disclose

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the handle to comprise a gel material and a region of material that is relatively hard compared to the gel material.

11. DeLuca teaches a tool with a handle portion, where the handle comprises a gel material (108) and region that is relatively hard as compared to the gel material (210, 230, 250). The region defines the outer surface of the handle and the gel material protrudes outwardly through an aperture (254) formed in the region. DeLuca uses this arrangement to provide a comfortable, deformable grip, that conforms to the users grip. It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Mooty, such that Mooty includes the gel material and region of DeLuca around its grip, in order to provide a comfortable, deformable grip that conforms to a user's grip.

12. With respect to claims 44 and 45, the combination discloses the handle to comprise a base (112, 114, 118 of DeLuca), and the region to comprise a cover piece (210, 230, 250) that retains the gel material on the base. The aperture (254) is formed in the cover material. The gel material is enclosed in a chamber (106 of DeLuca) formed between upper and lower layers (172, 174) of flexible film.

Response to Arguments

13. Applicant's arguments filed April 21, 2005, have been fully considered but they are not persuasive. Applicant argues that one skilled in the art would not look to the DeLuca reference to utilize it as a vibration dampener, and that combination of Mooty and DeLuca is result of hindsight reconstruction. Examiner respectfully disagrees.

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14. With regard to applicant's argument that one skilled in the art would not look to DeLuca to utilize it as a vibration damper, examiner notes that this argument appears to be directed toward the intended use of the claimed invention. Examiner notes the only claim in which the functional, or intended use, limitation of "vibration damping" is claimed is independent claim 12. Claims 14-25, 33-37, and 43-45 are silent as to the intended or functional use of the claimed structure. With respect to claims 14-25, 33-37, and 43-45, applicant's arguments appear to be narrower than the claims. Claim 12 sets forth a gel containing chamber that contains a "vibration damping gel material". DeLuca provides a device that provides "a cushioning effect" (abstract) that uses a gel material (column 12, lines 20-22) along with the other structural features substantially as claimed. Because DeLuca's gel is identical to applicant's claimed gel, it follows that DeLuca's gel is also capable of damping vibrations. Additionally, the fact that applicant has recognized another advantage (vibration damping) which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

15. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In this case, the combination of Mooty and DeLuca disclose all of the claimed limitations. DeLuca provides a motivation for combining, in that DeLuca's grip

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provides a cushioning effect which lends to a comfortable, deformable grip, that conforms to a user's grip. As discussed in the preceding paragraph, the fact that applicant has recognized another advantage (vibration damping) which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious.

Conclusion

16. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

17. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J. Kyle whose telephone number is 571-272-7057. The examiner can normally be reached on Monday - Friday, 8:30 am - 5:00 pm.

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19. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Judy Swann can be reached on 571-272-7075. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

20. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

mk


ROBERT J. SANDY
PRIMARY EXAMINER